

REMARKS

Claims 1-24 are pending in the present application. Claims 1-15 and 17-19 have been withdrawn from consideration without prejudice as a result of the restriction requirement. Claim 16 has been amended. Claims 20-24 have been added.

Claim Rejections – 35 U.S.C. § 112

Claim 16 was rejected under 35 U.S.C. § 112, ¶2. The Applicants have amended claim 16. The Applicants respectfully submit that this claim rejection has been overcome.

Claim Rejection – 35 U.S.C. § 103

Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patents No. 5,393,391 to Dietze et al. (“Dietze”) in view of U.S. Patent No. 3,773,646 to Mandel (“Mandel”) and U.S. Patent No. 5,997,817 to Crismore et al. (“Crismore”). The Applicants respectfully traverse this rejection.

Claim 16 is directed to an electrochemical sensor requiring, *inter alia*, a sacrificial insert the removal of which forms a capillary channel in the sensor. Further, claim 16 requires, *inter alia*, that the sacrificial insert (prior to removal) is positioned between first and second electrical contacts. The applied references, alone or in combination, do not teach, suggest, or disclose either of these limitations of claim 16.

The removable portion 45 of Dietze is said, by the office action, to be a “sacrificial insert” as that term is used in claim 16. *See* Office Action, ¶8. The Applicants respectfully disagree. Assuming, *argendo*, that Dietze discloses a “sacrificial insert” (which the Applicants disagree with), Dietze does not teach or suggest a sacrificial insert that is “positioned between said first electrical contact and said second electrical contact” as required by claim 16 (emphasis added). Rather, the removable portion 45 lays on top of the Dietze electrode unit 3. *See* Dietze at FIGS. 3 & 4. None of the applied references, or a combination thereof, teaches or suggests these limitations of claim 16.

A *prima facie* obviousness rejection requires that the prior art references must teach or suggest all of the limitations of the claim. *See* M.P.E.P. § 2143.03 (“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.”) (emphasis added). Because the applied references, alone or in combination, do not

teach, suggest, or disclose a “sacrificial insert positioned between said first electrical contact and said second electrical contact” as required, *inter alia*, by claim 16, the Applicants respectfully submit that the office action has not set forth a *prima facie* obviousness rejection. Thus, the Applicants respectfully submit that claim 16 is patentable over Dietze in view of Mandel and Crismore under 35 U.S.C. § 103(a) for at least these reasons.

New Claims

New claims 20-24, which depend from claim 16, have been added. To the extent that the Examiner considers the applied references relevant to new claims 20-24, the Applicants would respectfully traverse such a rejection. The Applicants respectfully submit that new claims 20-24 are patentable over the applied references for at least the above-discussed reasons that claim 16 is patentable over the applied references. *See M.P.E.P. § 2143.03* (“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.”).

Conclusion

In conclusion, the Applicants respectfully submit in view of the amendments and remarks set forth herein that all rejections have been overcome and that all claims are in condition for allowance, and such action is earnestly solicited.

If there are any matters that may be resolved or clarified through a telephone interview, the Examiner is respectfully requested to contact the Applicants’ undersigned attorney at the number indicated.

No fees are due in connection with the present Amendment and Reply. The Commissioner is authorized to deduct any fees required (except the issue fee) while this application is pending from Bayer HealthCare LLC Deposit Account No. 13-3375(MSE# 2616).

Respectfully submitted,

BAYER HEALTHCARE LLC,

Date: April 20, 2004

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